

REMARKS

I. Status of the Claims

Claims 18-26, 28-36 and 40-48 are pending in this application. Without prejudice or disclaimer, Applicants have amended claims 34, 41, and 44, which are discussed in detail below.

II. Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 34, 41, and 44 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

According to the Examiner, "[c]laim 34 is vague and indefinite, as it is confusing. Claim 34 depends on claim 33, but claim 33 is narrower than claim 34. Thus, it is not clear how claim 34 can depend from claim 33." Present Office Action, p. 2. Applicants agree with the Examiner that claim 33 is narrower in scope than claim 34. Thus, Applicants have amended claim 34 to properly depend from claim 32, which broadly recites "at least one propellant," since claim 33 is limited to propellants "chosen from volatile hydrocarbons." Thus, this point of rejection is overcome.

The Examiner also asserts that "[t]he phrase "after a period of time" in claims 41 and 44 is vague and indefinite, as this term is relative," since it is not clear what is meant by the phrase. *Id.*, p. 3. Applicants respectfully disagree with the Examiner. As a matter of law, as long as the scope of the claim when read in light of the specification is clear to one of ordinary skill in the art, the definiteness requirement is satisfied. See M.P.E.P. § 2173.05(b). Applicants respectfully submit that the phrase is clear, and that there is support for the phrase at page 17, line 18 of the present specification.

However, in order to advance prosecution of this case, Applicants have amended the claims to remove the phrase. Thus, this point of rejection has been overcome as well.

Accordingly, Applicants request that the Examiner withdraw these rejections.

III. Rejection under 35 U.S.C. § 103(a)

A. Feder in view of Dubief

The Examiner has rejected claims 18-21, 24-26, 28-32, 35, 36, and 40-45 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,721,026 to Feder et al. ("Feder") in view of U.S. Patent No. 6,024,946 to Dubief et al. ("Dubief").

As admitted by the Examiner, the composition of Feder is disclosed for cosmetic use for the treatment of hair and does not teach the "percent weight of the silicone, propellants, a hair setting lotion, and a process of rinsing the hair." Present Office Action, pp. 2-3. The Examiner therefore relies on Dubief to cure these deficiencies. According to the Examiner, it would have been obvious "to incorporate the propellant taught by [Dubief] into the invention of [Feder] because of the expectation of achieving a hair care composition, wherein the application of the composition can be controlled in amount and place." *Id.*, p. 4. Further, it also would have been obvious "to incorporate the percent weight teachings of [Dubief] into the invention of [Feder] because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art," *citing In re Aller. Id.*, pp. 4-5.

Applicants continue to disagree with the Examiner's reasoning for combining Dubief and Feder, as the Examiner apparently still does not fully appreciate the factual differences between the references. Moreover, the Examiner clearly has ignored the

proper legal framework for analyzing the references, in light of the After Final Amendment filed November 12, 2002, and entered after the filing of a Request for Continued Examination on filed January 14, 2003.

In particular, as Applicants have pointed out in the previous Responses to Office Actions, the Examiner has not pointed to any evidence in the references demonstrating a motivation or desirability to modify the composition of Feder to include the recited amount of the at least one non-aminated silicone α,ω -disilanol, i.e., the references disclose different compositions for different purposes. For instance, Feder and Dubief disclose different forms of siloxanes such that there would have been no motivation to modify the siloxane teachings of Feder with the siloxane teachings of Dubief, i.e., Feder discloses an α,ω (dihydroxy) polydiorganosiloxane emulsion, while Dubief does not disclose any siloxane in emulsion. Although Dubief discloses an oil-in-water emulsion of acrylamide/sodium 2-methyl propanesulfonate acrylamide copolymer and siloxanes such as octamethylcyclotetrasiloxane dimethiconol and dodecamethylcyclopentasiloxane, Dubief fails to disclose or suggest that its siloxanes are in an emulsion.

Thus, at best, it might be obvious to try to modify Feder with the teachings of Dubief, since Dubief discloses siloxanes and oil-in-water emulsions. The Examiner, however, cannot base a determination of obviousness on what the skilled person might try or find obvious to try. Rather, the proper test requires determining what the prior art would have led the skilled person to do; this the Examiner has not shown. See *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988) (internal citations omitted). The rejection is improper for at least these reasons.

The Examiner also points out that "the limitations 'at least one propellant' and 'wherein the composition is in the form of an aerosol' of the instant independent claims, necessitate that the composition be pressurized in an aerosol container. Present Office Action, p. 5. The Examiner uses a dictionary definition to further emphasize her point, which is that because Dubief teaches a propellant, the reference necessarily teaches a composition in a pressurized aerosol container. *Id.* Applicants do not entirely dispute the Examiner's interpretation of the claim language and her definitional analysis. However, her analysis indicates only that Dubief's compositions *may* contain, among other things, "propellants." Col. 7, lines 48-52. Moreover, the Examiner conveniently ignores that there is more than one definition for the broad term "propellant." See, e.g., American Heritage Dictionary (3rd ed. 2000) (defining "propellant" as something such as an explosive charge or a rocket fuel). Further, there is absolutely no evidence of record that proves that disclosing a "propellant" necessitates having a "container" to put it in.

In addition, even assuming that an "aerosol container" is suggested by Dubief, the rejection fails in view of the above stated reasoning, i.e., no clear and particular evidence of siloxanes in an emulsion and in the claimed amount.

Finally, Applicants note that the Examiner asserts that "[a]ny properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art," and that the burden is on "Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product." Present Office Action, pp. 5-6. Applicants disagree with the Examiner at least for the reason that inherency may not be established by probabilities or possibilities, and thus it is impermissible for her to shift the burden.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

In particular, the Examiner must provide factual and technical grounds establishing that the inherent feature *necessarily* flows from the teachings of the prior art. See *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990). In present case, however, all that the Examiner has done is merely assert that the prior art teaches the same components as instantly claimed, which hardly counts as a factual and technical ground for establishing inherency. For instance, the Examiner has not shown that the prior art necessarily teaches the instantly claimed cosmetic composition in the form of an aerosol. See instant claim 18. Thus, for these additional reasons, Applicants request that the Examiner withdraw this rejection.

B. Feder in view of Dubief, and further in view of Blankenburg

The Examiner has rejected claims 33-34 under 35 U.S.C. § 103(a) as being unpatentable over Feder in view of Dubief, and further in view of U.S. Patent No. 6,153,179 to Blankenburg et al. ("Blankenburg").

The Examiner admits that the combined teachings of Feder and Dupuis do not teach preferred propellants, but contends that it would have been obvious "to teach propane, butane, dimethyl ether, nitrogen, nitrous oxide or carbon dioxide, as taught by [Blankenburg], as the propellants of the combined references because of the expectation of achieving a cosmetically acceptable aerosol composition for application to the hair." Present Office Action, p. 6.

Applicants disagree at least for the reason, as discussed above, that Dubief only generally mentions, among many other disclosed additives, that propellants may be included in its compositions. In addition, in view of our discussion above, the Examiner has failed to provide any evidence showing a reasonable expectation of success in

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

making the claimed aerosol, or any of the other claimed embodiments. In fact, nothing of record in the previous Office Actions addresses this required showing either. Rather, the Examiner merely makes the broad conclusory statement that one skilled in the art would use the propellants of Blankenburg with the "expectation of achieving a cosmetically acceptable aerosol composition for application to the hair," leaving the reader to try to figure out the Examiner's rationalization. *Id.* As held by the Federal Circuit in *Dembiczak*, however, such conclusory statements are not a sufficient basis for a prima facie case. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Thus, the rejection is improper for at least this reason, and should be withdrawn.

C. Feder in view of Dubief, and further in view of Audousset

The Examiner has rejected claims 22-23 under 35 U.S.C. § 103(a) as being unpatentable over Feder in view of Dupuis, and further in view of U.S. Patent No. 6,106,577 to Audousset et al. ("Audousset").

The Examiner admits that the combined teachings of Feder and Dubief lack the preferred polymer particles, but contends that it would have been obvious "to substitute the specific polymer particles taught by [Audousset] for those taught by the combined references because the combined references generally teach the inclusion of such polymers in their compositions and because of the expectation of achieving a stable emulsion, wherein a surfactant is not necessary." Present Office Action, pp. 6-7.

Applicants respectfully disagree.

In particular, as discussed above, a general teaching of a claimed component in the prior art does not necessarily mean that one skilled in the art would selectively choose the component, or that there would be an expectation of success in achieving

the claimed invention. As emphasized by the Federal Circuit, the record must contain "substantial evidence" to support the Examiner's determinations of prima facie obviousness. *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Otherwise, the Examiner's assertions are nothing more than hindsight-based reasoning, which is improper. *Dembiczak* 175 F.3d at 999. In the present case, the Examiner has not shown any evidence, much less substantial evidence, that demonstrates a suggestion, motivation, or desirability to modify the combined teachings of Feder and Dubief with the polymer particles of Audousset. Thus, for at least this reason, the rejection is improper and should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 

Bryant L. Young
Reg. No. 49,073

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com